

BS01424

U.S. Application No. 10/036,923 Examiner LE, Art Unit 2171  
Resubmission of Amendment in Response to First Office Action

### **REMARKS**

In response to the Office Action dated July 14, 2004, Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the amended claims are in condition for allowance.

The United States Patent and Trademark Office (the "Office") rejected claims 1, 4, 6-14, 17, 19, 20, 21, and 24-35 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,463,585 to Hendricks *et al.* Claims 2, 3, 5, 16, 18, 23, and 36 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Hendricks*. Examiner Le, however, also indicates that claims 15 and 22 would be allowable if rewritten in independent form. The Assignee rewrites claims 15 and 22 as Examiner Le suggests, and the Assignee shows that the remaining claims are patentably distinguishable over *Hendricks*.

### **Allowability of Claims 15 and 22**

The Office indicates that claims 15 and 22 would be allowable if rewritten in independent form. The Assignee adopts the Examiner's suggestion and amends claims 15 and 22. Claims 15 and 22 are amended to incorporate all the limitations of the originally-presented, respective base claim. Examiner Le is thanked for allowing these claims.

### **Rejection of Claims under 35 U.S.C. § 102 (e)**

The Office rejected claims 1, 4, 6-14, 17, 19, 20, 21, and 24-35 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,463,585 to Hendricks *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As the Assignee shows, amended, independent claims 1, 17, and 24, and thus the dependent claims thereunder, are patentably distinguishable over *Hendricks*. The reference to *Hendricks* does not anticipate independent claims 1, 17, and

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24, so the Assignee respectfully requests that Examiner Le remove the 35 U.S.C. § 102 (e) rejection of the claims.

Independent claims 1, 17, and 24 have been amended. The independent claims describe a content-access-history database having a preference rating attribute. This preference rating attribute denotes the importance of a preference to a subscriber. Amended claim 1 is reproduced below:

1. (Currently Amended) A method for providing a content option list comprising:

receiving a preference for a subscriber from a content-access-history database, the content-access-history database comprising a preference rating attribute, said preference rating attribute denoting the importance of said preference to said subscriber;

searching a content database for content related to said preference;

receiving a first option list from said content database, wherein said first option list comprises an option ranked according to the preference and to the preference ranking attribute;

and

delivering said first option list to said subscriber.

Independent claims 17 and 24 include similar features. The content database supplies an option list that relates to the subscriber's historical preferences. This option list is ranked according to the subscriber's preference and according to the subscriber's preference ranking attribute. This option list is communicated to the subscriber.

*Hendricks* is completely silent to the features of claims 1, 17, and 24. Examiner Le is correct — *Hendricks* describes a method of using multiple cable channels to target advertisements to a demographic (*see, e.g.*, U.S. Patent 6,463,585 to Hendricks at the Abstract). The patent to Hendricks, however, fails to contemplate that a subscriber's historical preferences can be used as a filtering and ranking mechanism. Hendricks fails to realize that content can be "ranked according to the preference and to the preference ranking attribute," as claims 1, 17, and 24 require. *Hendricks*, in fact, is completely silent to "*preference rating attribute denoting the importance of said preference to said subscriber.*" Because *Hendricks* fails to teach these

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features, *Hendricks* cannot anticipate independent claims 1, 17, and 24. The Assignee, then, respectfully asks Examiner Le to remove the § 102 rejection and to allow the remaining pending claims.

**Rejection of Claims under 35 U.S.C. § 103 (a)**

The Office rejected claims 2, 3, 5, 16, 18, 23, and 36 under 35 U.S.C. § 103 (a) as being obvious over *Hendricks*. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter “M.P.E.P.”). As this response explains above, *Hendricks* does not teach or suggest all the features of independent claims 1, 17, and 24. The *prima facie* case of obviousness must fail.

Claims 1, 17, and 24 are not obvious in view of *Cook*. Independent claims 1, 17, and 24 all require “a preference rating attribute ... denoting the importance of said preference to said subscriber.” A content database supplies a first option list, and options are “ranked according to the preference and to the preference ranking attribute.” *Hendricks*, as explained above, is completely silent to this preference rating attribute. Examiner Le, in fact, admits that *Hendricks* fails to disclose this preference rating attribute. Thus, *Hendricks* in no way teaches or suggests the features of claims 1, 17, and 24. One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Hendricks* to rank options according to the preference rating attribute. Because *Hendricks* does not teach or suggest all the features of independent claims 1, 17, and 24, *Hendricks* cannot obviate the pending claims. The Assignee, then, respectfully requests removal of the 35 U.S.C. § 103 (a) rejection.

**Extra Claim Fees**

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Claims 15 and 22 are amended to independent form. As Examiner Lee suggests, claims 15 and 22 would be allowable if rewritten to incorporate all the features of the intervening base claim. The number of independent claims is now five (5), so an excess claim fee of \$172 is submitted with this response.

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,



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